

REMARKS**I. INTRODUCTION**

Claims 1 and 6 have been amended. Claim 15 has been added. The amendment to claim 1 is based on the originally filed claim 6. Newly added claim 15 is based on claim 1 and claim 8. Thus, claims 1-15 are now pending in the present application. No new matter has been added. Applicants would like to thank the Examiner for indicating that claims 8, 10-12, and 14 contain allowable subject matter. However, in view of the above amendments and the following remarks, Applicants respectfully submit that all presently pending claims are in condition for allowance.

II. THE 35 U.S.C. § 102(b) REJECTIONS SHOULD BE WITHDRAWN

Claims 1, 3, 5, 6, and 9 stand rejected under 35 U.S.C. § 102(b) as anticipated by Baggio et al. (U.S. Patent No. 4,910,881).

Claim 1, as amended, recites, “[a]n electrically heatable insole, comprising: at least one sole basic body; a cover layer; at least one heating electrode; at least one rechargeable battery electrically connected to the heating electrode; and a control circuit controlling a heating process and recharging the battery, wherein the heating electrode, the battery and the control circuit are disposed at least one of (i) in the sole basic body and (ii) between the sole basic body and the cover layer, wherein the control circuit includes (i) a remote control device switching the heating process on and off and (ii) a protective circuit disconnecting the battery in an event of a defect, and *wherein the remote control comprises a control part incorporated in the sole.*”

Baggio discloses a ski boot with a heating device that includes an insole (3) and an electric resistor (5) in a region (4) of the tip of the boot. (*See* Baggio, col. 3, ll. 1-3, Fig. 1). A control unit (16) is connected to the electric resistor (5) via conductors (11) and accumulators (10). (*Id.* at col. 3, ll. 23-26, Fig. 1). The control unit is “easily placed with a certain portion of the conductors 11 between the inner surface of the rear quarter 2

and the border 20, so as to secure the unit 16 in said position.” (*Id.* at col. 3, ll. 34-37, Fig. 4).

The Examiner refers to the conductors (11) and the control unit (16) of Baggio to meet the recitation in claim 1 of the control circuit and the remote control device, respectively. (*See* 3/24/11 Office Action, p. 2). However, Applicants respectfully submit that one of ordinary skill in the art would understand that since the conductors (11) do not control the resistor (5) or any other element in Baggio’s boot, then one of ordinary skill in the art would not consider the conductors (11) a control circuit. Also, the conductors (11) do not include “(i) a remote control device switching the heating process on and off and (ii) a protective circuit disconnecting the battery in an event of a defect,” as recited in claim 1. The conductors (11) merely serve to carry a signal from the control unit (16) to the accumulators (10).

However, even if one of ordinary skill in the art would consider the conductors a control circuit, which Applicants do NOT concede, claim 1 has been amended to recite, “*the remote control comprises a control part incorporated in the sole.*” Since, as previously stated, Baggio discloses that the control unit (16), which the Examiner equates to the claimed remote control device, is disposed on the rear quarter (2), then Baggio teaches away from “*the remote control comprises a control part incorporated in the sole.*” Therefore, Applicants respectfully request the withdrawal of the 35 U.S.C. § 102(b) rejection of claim 1 and its dependent claims 3, 5, 6, and 9.

Claims 1, 3, 5, 6, and 9 stand rejected under 35 U.S.C. § 102(b) as anticipated by Vaccari et al. (U.S. Patent No. 4,507,877). Claim 1 has been cited above.

Vaccari discloses a heater device for ski boots comprising an electric resistance heater (1) supplied by a battery (2). (*See* Vaccari, col. 2, ll. 25-30, Fig. 4). A foil (3), which spans the foot sole, functions to radiate the heat generated by the heater (1) over a larger surface area. The storage battery (2) is connected to a recharging socket (30) located at the upper portion of the inner shoe. The recharging socket (30) includes a

control switch (31). Vaccari also discloses a voltage limiter (5) which “intervenes between the resistance heater 1 and storage batteries 2 to disconnect the electric connection between the resistance heater 1 and storage batteries 2 as the voltage level of the storage batteries 2 drops below a threshold value which can be preset during the manufacturing stage.” (*Id.* at col. 3, ll. 20-28, Fig. 4). The voltage limiter is connected between the negative and positive poles of the storage battery (2). (*Id.* at col. 3, ll. 29-31).

The Examiner refers to the voltage limiter (15) and the combination of the recharging socket (30) and control switch (31) of Vaccari to meet the recitation in claim 1 of a control circuit and remote control device, respectively. (See 3/24/11 Office Action, p. 3). However, the combination of the recharging socket (30) and control switch (31) of Vaccari is placed in the upper portion of the inner shoe. (See Vaccari, col. 2, ll. 63-65, Figs. 1, 2). In contrast, claim 1 recites, “*the remote control comprises a control part incorporated in the sole.*” Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C. § 102(b) rejection of claim 1 and its dependent claims 3, 5, 6, and 9.

Newly added independent claim 15 is a combination of claim 1 and claim 8, which the Examiner has indicated contains allowable subject matter. (See 3/24/11 Office Action, p. 5).

III. THE 35 U.S.C. § 103(a) REJECTIONS SHOULD BE WITHDRAWN

Claim 4 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Baggio or Vaccari in view of Nikolaus (U.S. Publ. Appln. No. 2004/0237643). Claims 7 and 13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Baggio or Vaccari in view of Cioletti et al. (U.S. Patent No. 5,667,290).

Applicants respectfully submit that Nikolaus and Cioletti both fail to cure the above-identified deficiencies of Baggio and Vaccari and that Baggio, Vaccari, Nikolaus, and Cioletti, alone or in any combination, fail to disclose or suggest “*the remote control comprises a control part incorporated in the sole,*” as recited in claim 1. Because claims

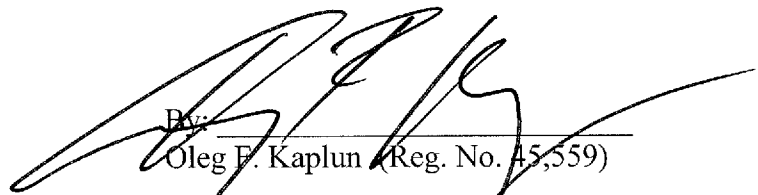
4, 7, and 13 depend on and, therefore, contain all of the limitations of claim 1, the withdrawal of the rejection of these claims is respectfully requested.

CONCLUSION

In light of the foregoing, Applicants respectfully submit that all of the pending claims are in condition for allowance. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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